

BS01326

U.S. Application No. 10/029,172 Art Unit 2612
Submission of Amendment with RCE in Response to September 25, 2006 Final Office Action

REMARKS

In response to the final Office Action dated September 25, 2006, the Assignee respectfully requests continued examination and reconsideration based on the above claim amendments and on the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents to *Safadi*, *Nissimov*, *Coss*, *Shintani*, *del Val*, *Feigen*, and *Bruynsteen*, whether considered alone or in any combination.

Claims 1-12 and 18-20 are pending in this application. Claims 13-17 have been canceled without prejudice or disclaimer.

The United States Patent and Trademark Office (the "Office") objected to FIGS. 1 and 2 for allegedly missing reference numerals. The Office also objected to Claim 18. Claims 1-17 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Claims 1-3 and 6 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,256,393 to *Safadi et al.* in view of U.S. Patent 5,327,549 to *Nissimov et al.* Claims 4 and 5 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Safadi* in view of *Nissimov* and further in view of U.S. Patent 6,170,012 to *Coss et al.* Claims 7-10, 12, 13-15, and 17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent Application Publication 2002/0095687 to *Shintani et al.* in view of *Safadi*, *Nissimov*, and *Coss*. Claim 11 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shintani* in view of *Safadi*, *Nissimov*, *Coss*, and U.S. Patent 6,128,653 to *del Val et al.* Claim 16 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shintani* in view of *Safadi*, *Nissimov*, *Coss*, and U.S. Patent Application Publication 2002/0138554 to *Feigen et al.* Claims 18-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,925,566 to *Feigen et al.* in view of U.S. Patent 6,658,663 to *Bruynsteen et al.*

The Assignee shows, however, that the drawings and pending claims fully comply with the patent laws and regulations. The pending claims additionally distinguish over the cited

BS01326

U.S. Application No. 10/029,172 Art Unit 2612
Submission of Amendment with RCE in Response to September 25, 2006 Final Office Action

documents to *Safadi, Nissimov, Coss, Shintani, del Val, Feigen, and Bruynsteen*, whether considered alone or in any combination.

Objection to the Drawings

The Office continues to object to FIGS. 1 and 2 for allegedly missing reference numerals. The Assignee, however, finds no missing reference numerals. The Assignee includes photocopies of FIGS. 1 and 2, and the allegedly missing reference numerals are circled. The Assignee thus considers this objection to be an error.

Objection to Claim 18

The Office objected to claim 18 for incorrect terminology. Claim 18 has been amended to fully comply with the patent laws and regulations. Examiner Hossain is thanked for the keen eye.

Rejections under 35 U.S.C. § 112

Claims 1-17 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Claims 1-12 have been amended and do not resemble their previous form, so the rejection is moot.

Claims 13-17 have been canceled, so the rejection of these claims is also moot.

Rejection of Claims 1-3 & 6 under 35 U.S.C. § 103 (a)

Claims 1-3 and 6 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,256,393 to *Safadi et al.* in view of U.S. Patent 5,327,549 to *Nissimov et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there

BS01326

U.S. Application No. 10/029,172 Art Unit 2612
Submission of Amendment with RCE in Response to September 25, 2006 Final Office Action

must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Claims 1-3 and 6 are not obvious. These claims recite, or incorporate, features that are not taught or suggested by the combined teaching of *Safadi* and *Nissimov*. Independent claim 1, for example, recites a "*the port receiving an operating instruction*" and a processor "*executes the operating instruction to repartition the capacity of a disk drive.*" Support for such features may be found at least at paragraphs [0047] and [0049]. Dependent claim 2 recites "*wherein the operating instruction causes the processor to limit the capacity of the disk drive.*" Support for such features may be found at least at paragraph [0050]. Dependent claim 3 recites "*wherein the operating instruction causes the processor to increase the capacity of the disk drive.*" Support for such features may be found at least at paragraph [0052].

Safadi and *Nissimov* do not obviate these features. *Safadi* discloses methods for providing authorization and access control of a software object ("BIOS") residing in a set-top terminal. *Nissimov* discloses a BIOS extension that allows access to disk drive parameters, such as storage capacity. While the combined teaching of *Safadi* and *Nissimov* may teach how the capacity of a set-top terminal's disk drive may be described, no where does *Safadi* and *Nissimov* disclose a processor that "*executes the operating instruction to repartition the capacity of a disk drive.*" Because the combined teaching of *Safadi* and *Nissimov* is silent to at least these features, one of ordinary skill in the art would not think that claims 1-3 and 6 are obvious. The *prima facie* case fails, so Examiner Hossain is respectfully requested to remove the § 103 (a) rejection.

Rejection of Claims 4 & 5 under 35 U.S.C. § 103 (a)

Claims 4 and 5 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Safadi* in view of *Nissimov* and further in view of U.S. Patent 6,170,012 to Coss *et al.* Claims 4 and 5, however, depend from independent claim 1 and, thus, incorporate the same distinguishing features. Because the combined teaching of *Safadi*, *Nissimov*, and Coss is silent to at least these features, one of ordinary skill in the art would not think that claims 4 and 5 are obvious. The

BS01326

U.S. Application No. 10/029,172 Art Unit 2612
Submission of Amendment with RCE in Response to September 25, 2006 Final Office Action

prima facie case fails, so Examiner Hossain is respectfully requested to remove the § 103 (a) rejection.

Rejection of Claims 7-10, 12, 13-15, & 17 under 35 U.S.C. § 103 (a)

Claims 7-10, 12, 13-15, and 17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent Application Publication 2002/0095687 to Shintani *et al.* in view of *Safadi*, *Nissimov*, and *Coss*.

Claims 13-17 have been canceled, so the rejection of these claims is moot.

Claims 7-10 and 12 are not obvious. These claims recite, or incorporate, features that are not taught or suggested by the combined teaching of *Shintani*, *Safadi*, *Nissimov*, and *Coss*. Independent claim 7, for example, recites "*a processor coupled to the first port, the second port, the tuner, and the resource manager, the processor executing the operating instruction to repartition the capacity of a disk drive.*" Dependent claim 12 additionally recites "*after the operating instruction has been executed, receiving an interrogation via the second port that again retrieves the resource information to verify the disk drive was repartitioned.*" Support for claim 12 may be found at least at paragraph [0055]. Because the combined teaching of *Shintani*, *Safadi*, *Nissimov*, and *Coss* is silent to at least these features, one of ordinary skill in the art would not think that claims 7-10 and 12 are obvious. The *prima facie* case fails, so Examiner Hossain is respectfully requested to remove the § 103 (a) rejection.

Rejection of Claim 11 under 35 U.S.C. § 103 (a)

Claim 11 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shintani* in view of *Safadi*, *Nissimov*, *Coss*, and U.S. Patent 6,128,653 to del Val *et al.* Claim 11, however, depends from independent claim 7 and, thus, incorporates the same distinguishing features. Because the combined teaching of *Shintani*, *Safadi*, *Nissimov*, *Coss*, and *del Val* is silent to at least these features, one of ordinary skill in the art would not think that claim 11 is obvious. The

BS01326

U.S. Application No. 10/029,172 Art Unit 2612
Submission of Amendment with RCE in Response to September 25, 2006 Final Office Action

prima facie case fails, so Examiner Hossain is respectfully requested to remove the § 103 (a) rejection.

Rejection of Claim 16 under 35 U.S.C. § 103 (a)

Claim 16 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shintani* in view of *Safadi*, *Nissimov*, *Coss*, and U.S. Patent Application Publication 2002/0138554 to Feigen *et al.* Claim 16, however, has been canceled, so the rejection is moot.

Rejection of Claims 18-20 under 35 U.S.C. § 103 (a)

Claims 18-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,925,566 to Feigen *et al.* in view of U.S. Patent 6,658,663 to Bruynsteen *et al.* Claims 18-20, however, recite, or incorporate, features that are not taught or suggested by the combined teaching of Feigen and Bruynsteen. Independent claim 18, for example, recites "*executing the operating instruction to repartition the capacity of a disk drive.*" Because the combined teaching of Feigen and Bruynsteen is silent to at least these features, one of ordinary skill in the art would not think that claims 18-20 are obvious. The *prima facie* case fails, so Examiner Hossain is respectfully requested to remove the § 103 (a) rejection.

If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or scott@wzpatents.com.

Respectfully submitted,



Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390